

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex Parte

ALAN. S. HODES

Application for Patent: 10/788,532

Filed: February 27, 2004

Group Art Unit 2163

Examiner Patrick A. Darno

For:

Patent Analysis and Formulation Using Ontologies

REPLY BRIEF

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1. STATUS OF CLAIMS

The following claims have been rejected and appealed: claims 1-25.

The following claims have been cancelled: NONE.

The claims on appeal are reproduced below in the Appendix at Section 9 of this Appeal Brief.

2. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Ground I:

Claims 1, 6, 13, 14 and 21 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of co-pending Application No. 11/151,781.

Ground II:

Claims 3-4 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Ground III:

Claims 1-5, 11-14, and 18-25 are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent Application Publication Number 2002/0111941 to Claude Roux et al. (“Roux”) further in view of U.S. Patent Application Publication Number 2004/0181427 to Gregory A. Stobbs (“Stobbs”).

Ground IV:

Claims 6-10 are rejected under 35 U.S.C. 103 as being unpatentable over Roux in view of Stobbs and further in view of U.S. Patent Number 6,711,585 to Max Copperman et al. (“Copperman”).

Ground V:

Claims 15-17 are rejected under 35 U.S.C. 103 as being unpatentable over Roux in view of Stobbs and further in view of Non-Patent Literature article titled “Generating Patent Claims from Interactive Input” by Svetlana Sheremetyeva et al. (“Sheremetyeva”)

3. ARGUMENT

With respect to Applicant's genus/species discussion relative to the rejection of claim 1, on page 17 of the Examiner's Answer, the Examiner states:

First, the Examiner respectfully points out that the Examiner did not reject claim 1 as anticipated under any subsection of 35 U.S.C. 102. However, the Appellant refers to sections of the MPEP, and bases his argument, on an issue (Genus-Species Situation) that is commonly associated with anticipation rejections under 35 USC 102 (see MPEP 2131-2131.02).

Since the claims were actually rejected under 35 U.S.C. 103(a) as being obvious over the prior art of record, Appellants arguments against whether the prior art "anticipates" the claimed invention are indeed irrelevant. Therefore, the Appellant's arguments set forth above are effectively rendered moot.

Applicant contends that it is entirely appropriate to rely on these sections, since the Examiner has stated that, emphasis added, "Roux discloses a method of analysis regarding at least one patent claim, comprising:" (Page 3 of Final Office Action); and "determining a correspondence of the portions of at least one patent claim to concept nodes of an ontology." The Examiner has not contended that it would be obvious to modify Roux to yield these features.

Furthermore, the Examiner states "The only argument set forth from the Appellant (in a broad sense) is that a computer program would handle a patent claim different that plain text." It is a gross mischaracterization to say that this is Applicant's argument. For example, Applicant has argued strenuously that:

However, the Examiner has argued completely the opposite, which is improper and has no legal basis whatsoever. The Examiner simply has not made a prima facie case that the Roux reference "discloses" processing a "claim."

More succinctly, the Examiner has argued that Roux discloses processing a claim. Applicant has argued that Roux clearly and unambiguously does not disclose processing a claim and, furthermore, that processing a claim yields unexpected results, in that it further allows for making determinations of validity/patentability.

The Examiner's logic that Roux discloses processing a claim is incorrect.

4. CONCLUSION

In view of the foregoing and the arguments set forth in the Appeal Brief, it is respectfully submitted that the Examiner's rejections are erroneous. Accordingly, the rejections should be reversed.

Respectfully submitted,

/ASH/
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